

BEST AVAILABLE COPY

REMARKS

This paper is being submitted in response to the Office Action mailed in the application on November 18, 2004. Claims 1-9 are pending. Claims 1, 3, 4, 6 and 9 have been amended.

The Examiner has rejected applicant's claims 1-8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has rejected applicant's claims 1-7 and 9 under 35 U.S.C. § 102(b) as being anticipated by Imai et al. (U.S. Patent No. 6,771,882). The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Imai et al. in view of Watanabe (U.S. Patent No. 6,272,280). With respect to applicant's claims, as amended, the Examiner's rejections are respectfully traversed.

With regard to the rejection of claims 1-8 under 35 U.S.C. § 112, the Examiner states that these claims contain subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, according to the Examiner, the "second recording medium" in line 20 of Claim 1 is not shown in Fig. 1B or in the specification, and Figs. 2-4 show recording at different areas of one recording medium, T. Applicant has amended claim 1 to delete the reference to a "second" recording medium on line 20 of claim 1 and submits that such claim, and its respective dependent claims 2-8, now comply with the enablement requirement of 35 U.S.C § 112, first paragraph.

With regard to claims 1-7 and 9, the Examiner states that Imai et al. shows a recording apparatus (3 in Fig. 16), comprising recording mode setting means (rotary drum 101 shown in Fig. 3) for setting a first recording mode (SD mode) having a first information quantity per unit time (one frame of data is recorded on ten tracks), and a second recording mode (SDL mode) with a second information quantity (two frames of data are recorded on ten tracks) larger than

BEST AVAILABLE COPY

the first information quantity per unit time. According to the Examiner, Imai et al. further discloses recording means (recording section 24 in Fig. 22) for recording image data on a recording medium; and control means (control section 25 in Fig. 22) for controlling the recording means to record on the recording medium still image data and detection data for detecting the still image according to a recording instruction of the still image. Applicant respectfully submits that Imai et al. does not teach or suggest the recording apparatus of applicant's amended claims.

Applicant's claims 1, 3, 4, 6 and 9 have been amended to clarify the feature of applicant's invention. In particular, claim 1, which is directed to a recording apparatus with first and second recording modes (SD and SDL) having different information quantities per unit time, has been amended to include instruction means for instructing recording of a still image, and control means for controlling the recording means to record on the recording medium still image data and detection data for detecting the still image data recorded on the recording medium in response to a recording instruction of the still image.

Claim 1 has been further amended to clearly recite that the recording apparatus is arranged to control recording of still image data (e.g., 202 and 402 in Figs. 2 and 4) and detection data (204 and 404 in Figs. 2 and 4) for detecting the recorded still image data, in accordance with a recording instruction so that the still image data is recorded on a recording medium for a first recording period (such as 6.5 seconds, as shown in Fig. 2) when the first recording mode is set, and the still image data is recorded on the recording medium for a second recording period (such as 8.5 seconds as shown in Fig. 4) when the second recording mode is set. Claim 1 further recites that the second recording period is different in length from the first recording period, and that the length of the first recording period is set according to a

BEST AVAILABLE COPY

first recording mode and the length of the second recording period is set according to a second recording mode. Claim 9, which is also directed to a recording apparatus, has been similarly amended.

These features are not taught or suggested by the cited Imai et al. patent. According to Imai et al., a recording apparatus (3 in Fig. 22) records moving image data using DV format (i.e., SD and SDL modes having different tape speeds, respectively). Imai et al. also teach recording still image data on a recording medium (col. 10, line 39-50; Fig. 20). However, while Imai et al. teach recording at different tape speeds, they also teach the use of recording periods which are the same in each of the first and second recording modes. Thus, Imai et al. do not teach or suggest changing a recording period of recording still image data in accordance with the SD or SDL recording mode that has been set.

In other words, Imai et al. fail to teach or suggest control means for controlling recording means to record on the recording medium the still image data for a first recording period when the first recording mode is set by said recording mode setting means, and to record on the recording medium the still image for a second recording period different in length from the first recording period when the second recording mode is set, and wherein a length of the first recording period is set according to the first recording mode, and a length of the second recording period is set according to the second recording mode, as required by applicant's amended claims. This feature of applicant's invention enables changing the length of recording period of still image data between the first and second recording modes. There is simply no teaching in Imai et al. of this feature of applicant's invention.

With regard to claim 8, Watanabe adds nothing to change this conclusion. As noted by the Examiner, Watanabe teaches using photo picture identification (or PPID) as a means for

BEST AVAILABLE COPY

detecting and reproducing recorded still image data. Watanabe fails, however, to teach or suggest recording still image data for different recording periods set according to the SD and SDL recording modes, respectively.

In view of the above, it is submitted that applicant's claims, as amended, ~~patently~~ distinguish over the cited art of record. Accordingly, reconsideration of the claims ~~is~~ respectfully requested. If the Examiner believes that an interview would expedite consideration of this Amendment or of the application, a request is made that the Examiner telephone applicant's counsel at (212) 790-9278.

Dated: February 18, 2005

Respectfully submitted,

Alexandra B. Urban

COWAN, LIEBOWITZ & LATMAN, P. C.
1133 Avenue of the Americas
New York, New York 10036
T (212) 790-9200

Alexandra B. Urban
Reg. No. 45,171
Attorney of Record